Atty. Docket No.: 8C20.1-860
Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED
CENTRAL FAX CENTER
FEB 26 2007

In re application of: WUTHNOW, Mark	
Serial No.: 10/789,616	Art Group: 2614
Filed: February 27, 2004	Examiner: PATEL, Hemant Shantilal
For: "SYSTEM AND METHOD FOR VOICEMAIL SERVICE IN AN ENVIRONMENT HAVING MULTIPLE VOICEMAIL TECHNOLOGY PLATFORMS"	Confirmation No.: 7645

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

February 26, 2007
Filed Via Facsimile

Sir:

Applicant requests review pursuant to the Pre-Appeal Brief Conference Pilot Program. 1296 Off. Gaz. Pat. Off. 67 (12 July 2005, and extended 10 January 2006).

This request is submitted along with a Notice of Appeal and the requisite fee therefor and is filed within three months of the mailing date of the Office Action. Thus, no extension of time is believed due. In the event that any extensions of time are required, please consider this a request therefor. The Commissioner is authorized to charge any additional fees due or credit any overpayment to Deposit Account 50-1513.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted to the U.S. Patent and Trademark Office via facsimile to 571-273-8300 on the date indicated below.

Michelle E. Kandcer — Date 02/26/2007

PAGE 1/8 * RCVD AT 2/26/2007 6:02:50 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-5/14 * DNIS:2738300 * CSID:770 984 0098 * DURATION (mm-ss):02-34

RECEIVED
CENTRAL FAX CENTER
FEB 26 2007

Status of Claims:

Claims 1-25 remain pending in the present application and stand finally rejected. As explained in more detail below, Applicant submits that the present grounds of rejection cannot be sustained. Accordingly, Applicant believes that all claims are in condition for allowance and respectfully requests such action.

The Standing Rejections Are Clearly Deficient and Without Basis:

Claims 1-9 and 11-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Spielman* (US Patent No. 6,560,318) and further in view of *Jones* (US Patent No. 5,193,110). This rejection is erroneous and cannot be sustained.

For a rejection to be proper under 35 U.S.C. §103(a), there must be some suggestion or motivation to combine the references, and the combination must teach every element in the claim. The rejection is improper because neither of the requirements is met.

The present invention is directed to a system where a subscriber being called has a preferred voicemail technology platform associated with his subscriber account. Thus, when an incoming call is made to the subscriber's device and upon a triggering event which indicates that the caller should be connected to voicemail, the system figures out which voicemail technology platform is associated with the device and selects that particular voicemail platform such that a voicemail message can be stored on that particular platform. For example, if an MMS-based voicemail system platform is selected, the message can be delivered and stored on the subscriber's terminal (e.g., a cell phone). However, if an NVMS platform is selected, then the message can be delivered to and stored on a network-based storage device. Hence, the system of the present invention selects a technology platform that is either local to the device or that is a centralized storage device. Additionally, it is possible that there are multiple voicemail technology platforms (such as different software or technologies) that the system selects from within the network and/or the user device.

The *Spielman* reference discloses an Internet-based system for delivering an email message notification to multiple devices via a single protocol, which is SMTP. The *Jones* reference describes a PBX-type system that routes voicemail to a default ("home")

voicemail processing unit (VPU) and rolls the voicemail to the next available VPU if the first one is unavailable at the moment. There is simply no mention in *Jones* of using different voicemail technology platforms – instead, it appears that the VPU's are all the same.

There is absolutely no valid suggestion or motivation to combine the references. The suggested combination of references here is nothing more than hindsight reconstruction based on Applicant's teaching, which, of course, is legally impermissible. There is simply no motivation to combine these two nonanalgous pieces of art. Clearly, the Examiner has used the Applicant's claims as a roadmap to improperly combine an email message notification delivery system of *Spielman* with a PBX-type system *of Jones* for routing voicemail messages in an attempt to show all elements of the Applicant's claimed invention. Such conduct is improper. Accordingly, reconsideration and withdrawal of the §103(a) rejection is respectfully requested.

Moreover, even if the proposed combination were made, the combination of *Spielman* and *Jones* does not teach the claimed invention. Neither of the references discloses, teaches, or suggests the use of voicemail technology platform indicator information to select one of multiple voicemail technology platforms for receiving a call, as claimed. Simply put, *Spielman* does not teach a system for providing voicemail services in an environment having multiple voicemail technology platforms. Nothing in the passages cited by the Examiner shows that *Spielman* is concerned with selecting an appropriate voicemail platform from among multiple voicemail technologies, such as NVMS or MMS.

Rather, *Spielman* discloses an email message notification process used after a message is stored in a message store or external source. The *Spielman* system delivers a notification delivery message to a secondary mailbox associated with the subscriber's preferred notification device (e.g., cell phone, facsimile, pager, etc.) via a single protocol, namely SMTP. Clearly, the platform selector element of the present invention is not the same as the notification process of *Spielman*. *Spielman* simply does not select a voicemail technology platform from one of said multiple voicemail technology platforms for receiving said call. Rather, after the message is received, the *Spielman* system then uses a secondary mailbox. *Spielman* does not disclose an element that selects an appropriate voicemail technology platform for receiving a call. In short, the *Spielman* system receives

the message on a single platform and then forwards a notification to a preferred notification device that the message is available.

Jones fails to cure the deficiencies of *Spielman*. In *Jones*, a PBX-type system is disclosed in which the system routes voicemail to a default ("home") voicemail processing unit (VPU) and rolls the voicemail to the next available VPU if the first one is unavailable at the moment. There is no mention of using different voicemail technology platforms – instead, it appears that the VPU's are all the same. Moreover, the *Jones* system does not determine what voicemail technology platform (or even which VPU) is indicated for the particular number being called. Instead, *Jones* appears to disclose a one-size-fits-all approach. This is not surprising since *Jones* appears to be directed to an enterprise-level system, like a PBX, in which the end users' phones (which here in *Jones* are land-line phones) are all the same. There are no subscribers in *Jones* and *Jones* does not describe that different subscribers would employ different voicemail technology platforms. It is little wonder then that *Jones* does not describe selecting the correct voicemail technology platform for the particular subscriber being called as none of this environment, problem, or solution is anywhere mentioned in *Jones*.

If the present invention were <u>somehow</u> described in *Jones*, then the VPUs (voice processing units) of *Jones* would each be different and not the same. Moreover, some of the VPUs would be located locally on the phone and some of the VPUs would be in a centralized location on the network. The *Jones* system would then select the appropriate voicemail technology platform that is associated with the particular subscriber's account. <u>Clearly, this is not what *Jones* describes</u>. Instead, all of the VPUs in *Jones* are the same. *Jones* describes that an incoming call is routed to a default or "home" VPU and if the default VPU is not available (such as when it is at capacity), the system routes the call to the next available VPU. This is not what is being claimed and *Jones*, alone or in combination with *Spielman*, does not meet the claimed invention.

The independent claims 1, 8, 16, and 19 (and by dependency claims 2-7, 9-15, 17-18, and 19-21), all recite that platform selector element is operative to "select one of said multiple voicemail technology platforms for receiving said call, recording a message from said caller to said subscriber, and storing said message on said selected voicemail

PAGE 4/8 * RCVD AT 2/26/2007 6:02:50 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-5/14 * DNIS:2738300 * CSID:770 984 0098 * DURATION (mm-ss):02-34

technology platform for later retrieval," which is not disclosed, taught, or suggested by *Spielman* or *Jones*, either individually or in combination. Moreover claim 22 (and by dependency claims 23-25) recites a platform selector element operative to "select a voicemail technology platform by using said voicemail technology platform indicator information; and ... record a voicemail message on said selected voicemail technology platform from said caller to said subscriber," which is not disclosed, taught, or suggested by *Spielman* or *Jones*, either individually or in combination. Accordingly, reconsideration and withdrawal of the §103(a) rejection of is respectfully requested.

Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Spielman* (US Patent No. 6,560,318) in view of *Jones* (US Patent No. 5,193,110) and further in view of Wheeler (US Patent No. 5,572,583).

For at least the reason that that claim 10 depends from allowable claim 8, and therefore incorporates the limitations of claim 8, this dependent claim is patentable over the art of record for at least the reasons set forth above with respect to independent claim 8. Accordingly, reconsideration and withdrawal of the §103(a) rejection of is respectfully requested.

In view of the above, it is clear that an essential element necessary to properly establish a *prima facie* obviousness rejection under §103 is lacking, and that an appeal would be a waste of the Office's and the Applicant's resources. Accordingly, reconsideration and withdrawal of the stated ground of rejection is respectfully requested, and favorable indication of allowance is earnestly solicited.

Respectfully submitted,

GARDNER GROFF SANTOS &
GREENWALD, P.C.

Michelle E. Kandcer
Reg. No. 54,207

Customer Number: 39513
GARDNER GROFF SANTOS & GREENWALD, P.C.
Tel: 770/984-2300
Fax: 770/984-0098

PAGE 5/8 * RCVD AT 2/26/2007 6:02:50 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-5/14 * DNIS:2738300 * CSID:770 984 0098 * DURATION (mm-ss):02-34

RECEIVED
CENTRAL FAX CENTER
FEB 26 2007

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
8C20.1-860

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted to the U.S. Patent and Trademark Office via facsimile to 571-273-8300 on the date indicated below.

/Michelle E Kandcer/ 02/26/2007
Michelle E. Kandcer Date

Application Number	Filed
10/789,616	February 27,2004

First Named Inventor
WUTHNOW, Mark

Art Unit	Examiner
2614	PATEL, Hemant Shantilal

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
  See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
  (Form PTO/SB/96)
- ☒ attorney or agent of record.
  Registration number 54,207
- ☐ attorney or agent acting under 37 CFR 1.34.
  Registration number

/Michelle E Kandcer/
Signature

Michelle E. Kandcer
Typed or printed name

770.984.2300
Telephone number

February 26, 2007

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.
If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.